

**REMARKS**

Applicant has carefully studied the Examiner's Action mailed March 8, 2006 and all references cited therein. These explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

***Claim Rejections - 35 U.S.C. § 102***

Applicant acknowledges the quotation of 35 U.S.C. § 102(e). Claims 1 and 2 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Daniels (U.S. 6,904,248).

Applicant respectfully renews its objection to the Office's assertion that Daniels teaches a toner cartridge having a waste bin with a leading end sculpted to mate with a plurality of printer families (Office Action, page 4). Daniels clearly teaches a method of altering one type of process cartridge to be converted to another by altering its physical characteristics (Col. 2, lines 22-26). The toner cartridge of Daniels can only be used in the single printer chosen prior to altering the toner cartridge. In response to this clarification, the Office has stated that the claims are anticipated by Daniels since they do not recite the limitation that each cartridge can be placed in each of the printers without any modification to the cartridge.<sup>1</sup>

Respectfully, claims are not to be read in a vacuum, and limitations therein are to be given interpreted in light of the specification in giving them their broadest reasonable interpretation. Moreover, MPEP §2114 expressly states that even if the prior art device performs all the functions recited in a claim, the prior art cannot anticipate the claim if there is any structural difference. Here, Applicant claims a toner cartridge having a leading end sculpted to mate with the cartridge receiving cavity of a plurality of printer families. The prior art presents a method of structurally altering a cartridge to provide a toner cartridge which the Office alleges to perform the same function. Even assuming, for purpose of illustration only, all facts in favor of the Office, the waste bin of Daniels is clearly not sculpted but modified.

For example, in *Ex parte John C. Fournier*<sup>2</sup> the Board held that a toner cartridge which claimed a tab that is "integrally formed with said container," was to be read to mean that the tab "is formed as a portion of the container at the same time the container is formed." The rejection was reversed since the prior art was devoid of an analogous integral structure. Here, Applicant claims a sculpted front end. The

<sup>1</sup> Office Action, page 6

<sup>2</sup> Board of Patent Appeals and Interferences, Appeal No. 1998-0546, Application No. 08/560,507 (unpublished)

normal usage of the word "sculpted" does not normally conjure thoughts of transient shapes. Claim 1, however, has been amended to replace the term sculpted with "integrally formed" to remove any ambiguity.

Support for the amendment to the claims is found throughout the specification and claims as originally filed. Support can also be found in [Para. 00042], *inter alia*, "A plurality of recesses is *formed* in the leading end of the waste bin to enable the leading end to mate with a plurality of printers." Moreover, the figures clearly show that the wastebin is of unitary construction; see Figures 2A through 2J in particular.

#### ***Claim Rejections - 35 U.S.C. § 103***

Applicant acknowledges the quotation of 35 U.S.C. § 103(a). Claims 19 and 20, as well as 73-90, stand rejected under 35 U.S.C. § 103(a) as being anticipated by Daniels (U.S. 6,904,248). Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of Huss et al. (6,018,636).

Claims 19 and 20, are dependent, directly or indirectly, on claim 1, which has been shown to be patentable, and are therefore allowable as a matter of law.

The only support for the finding of obviousness, based upon a conclusion that Applicant's claimed invention is an obvious variation of the arrangement of recesses taught by Daniels, is the Office's apparent application of a *per se* rule. Applicant respectfully reminds the Office that the rules regarding a finding of obviousness are not mechanical and their application was never intended, nor allowed, to short circuit the determination of obviousness based on a thorough analysis, as mandated by 35 U.S.C. § 103.<sup>3</sup>

For example, in *Ex parte Giles*,<sup>4</sup> the examiner's § 103 rejection based on an allegedly obvious reversal of parts was reversed because evidence proffered by the examiner was devoid of any teaching that would have suggested the *particularly claimed* combination of elements. Moreover, in *Ex parte Chicago Rawhide Mfg. Co.*,<sup>5</sup> the mere fact that an ordinarily skilled artisan *could* rearrange the parts of the reference device to meet the terms of the claims was not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the artisan, without the benefit of the current specification, to make the necessary changes in the referenced device. Also the Action in this case does not cite any factual basis to support the conclusory finding that it would have been obvious to

<sup>3</sup> *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) ("The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention-including all its limitations-with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease.")

<sup>4</sup> *Ex parte Giles*, 228 USPQ 866, 867 (Bd. Pat. App. & Int. 1985)

<sup>5</sup> *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Int. 1984); See also MPEP § 2144.04

rearrange Daniels to arrive at the specific combinations set forth in Claims 73 through 90. A similar failure lack of facts to support the conclusion that it would have been obvious to rearrange certain parts of the prior art to arrive at the combination set forth in the claims constituted was sufficient reason necessitating reversal of the standing §103 rejection in *Ex parte Grasenick*.<sup>6</sup>

Independent claims 73 and 82 have been amended to include the express limitation "integrally formed." As discussed above, this amendment is not necessitated by the prior art but merely makes express what was previously inherent. The use of a toner cartridge having integrally formed recesses has utility over the prior art, specifically reducing potential point of failure as well minimizing construction costs and time. Moreover, modifying Daniels to include a wastebin of unitary construction, with respect to the recesses, would render the prior art unsatisfactory for its intended purpose; namely allowing modification of various types of printer cartridges. Accordingly, claims 73 and 90, as well as the claims that depend there from, cannot be rendered obvious absent a reference suggesting a wastebin having a plurality of recesses integrally formed therewith.

#### Conclusion

Entry of a Notice of Allowance is solicited. If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (813) 925-8505 is requested.

Very respectfully,

SMITH & HOPEN

By: 

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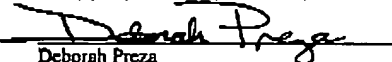
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#### CERTIFICATE OF FACSIMILE TRANSMISSION

(37 C.F.R. 1.8 (a))

I HEREBY CERTIFY that this Amendment B, including Amendments to the Claims and Remarks, are being transmitted by facsimile to the United States Patent and Trademark Office, Art Unit 2852, Attn: Sandra L. Brase, (571) 273-8300, on June 8, 2006.

Date: June 8, 2006

  
Deborah Preza

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<sup>6</sup> *Ex parte Grasenick* 158 USPQ 624 (Bd. App. 1967)